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Docket No. EJO0010U/US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT OF:
Joel F. PLOTKIN

:

APPLICATION NO: 09/513,960

: EXAMINER: OFFICE OF
PETITIONS AND SPECIAL
PROGRAMS

FILED: February 28, 2000

FOR: A PROCESS FOR COMPUTER IMPLEMENTED MANUSCRIPT REVIEW

37 CFR 1.181 PETITION FROM MAILING OF A FINAL OFFICE ACTION
IN RESPONSE TO AN APPEAL BRIEF

I. Statement of the Precise Relief Requested

The applicant requests that the Director vacate the office action mailed 12/16/2004, vacate the finality of that office action, and instruct the examiner to respond to the appeal brief filed August 22, 2003, as required by 37 CFR 41.39, with an examiner's answer.

II. Material Facts in Support of the Petition

1. On June 5, 2002, Examiner Borissov mailed a non-final office action.
2. On November 20, 2002, Examiner Borissov mailed a non-final office action.
3. On May 7, 2003, Examiner Borissov mailed a non-final office action.
4. In response to the non-final office action mailed May 7, 2003, on August 22, 2003 the applicant timely filed an appeal brief under 37 CFR 1.192; and an amendment under 37 CFR 1.111.
5. On January 13, 2004, Examiner Borissov mailed an office communication. In the office communication, the examiner stated that:

Appellant's Appeal Brief is defective because it includes amended versions of claims which were not previously entered and examined on the merits.

MPEP 1207 States: "Entry of a new amendment, new affidavit or new evidence in an application on appeal is not a matter of right."

Since applicant's amended version of claims have not been previously entered, and are not entered on appeal as a matter of right, they cannot be entered with the appeal brief. Appellant is required to submit a new brief that only includes and addresses the version of the claims that existed at the time of Examiner's last office action.

Applicant has a shortened statutory period of 30 days to reply. Extension of time may be granted. [Office communication page 2 lines 3-13.]

6. The applicant has timely filed a revised appeal brief herewith to comply with the examiner's requirement and to preserve the rights of the application.

7. On February 10, 2004, the applicants filed a petition requesting the following relief:

The applicant requests that the Director reinstate the amendment under 37 CFR 1.111 that the applicant filed August 22, 2003; and that the Director reinstate the original appeal brief under 37 CFR 1.192 that the applicant filed August 22, 2003. Once the amendment and the original appeal brief are reinstated, the applicant requests that the Director withdraw the revised appeal brief that the applicant filed herewith.

8. On September 28, 2004, the USPTO mailed a decision granting the petition identified in statement of fact number 6, stating that:

Applicant's petition under 37 CFR 1.181 filed February 10, 2004 in application Serial No. 09/513/960, requests to reinstate the amendment filed on August 22, 2003.

The petition is GRANTED.

The amendment filed on August 22, 2003 under 37 CFR 1.111 was in response to a second non-final office action mailed on May 7, 2003. Since the amendment filed on August 22, 2003 was timely filed in response to a non-final office action it should have been entered as a matter of right under 37 CFR 1.111. Therefore the notice of defective appeal brief mailed on January 13, 2004 indicating that appellant's appeal brief is defective because it included amended versions of claims, which were not previously entered, was in error and is hereby withdrawn.

The application [sic; file?] has been forwarded to the Examiner to consider the amendment and appeal brief filed on August 22, 2003.¹

9. On 12/16/2004, the USPTO mailed an office action in this application.
10. The 12/16/2004 office action indicates that it is in response to the amendment file 8/22/2003.
11. The 12/16/2004 office action does not indicate that it is in response to the appeal brief filed 8/22/2003.
12. The 12/16/2004 office action is marked "final."
13. The 12/16/2004 final office action is not an examiner's answer pursuant to either 37 CFR 1.193(b) or 37 CFR 41.39(a)(1).
14. The appeal brief filed 8/22/2003 was filed when 37 CFR 1.193 was in force. 37 CFR 1.193(b)(2) specified that an examiner could respond to an appeal brief by re-opening prosecution.
15. 37 CFR 1.193(b)(2) did not authorize an examiner to respond to an appeal brief by re-opening prosecution and making a new office action final.
16. 37 CFR 41.39 specifies the examiner's options in response to an appeal brief, which consist of: file an examiner's answer.
17. 37 CFR 41.39 became effective September 13, 2004. See 69 FR 49960.

¹ A copy of the decision mailed September 28, 2004 is attachment 1.

III. Reasons Why the Relief Requested Should be Granted

A. Why the Director Should Decide this Type of Petition

The Director instructed the examiner to consider the amendment and appeal brief filed 8/22/2003. What that meant in the context of this application was that the examiner was to consider the appeal brief filed 8/22/2003, which included the claims as amended by the amendment filed 8/22/2003. The examiner deviated from the Director's instruction by failing to consider the appeal brief filed 8/22/2003 by mailing a final office action responding to the amendment. Accordingly, the examiner's conduct should be reviewable by the Director, a petition for which lies under 37 CFR 1.181, to the Director, to invoke the Director's supervisory authority.

B. Why the 12/16/2004 Office Action is Improper and Should be Vacated

The 12/16/2004 final office action is improper because an office action is not an authorized under 37 CFR in response to an appeal brief, and because a final office action is not authorized under 37 CFR in response to an appeal brief.

1. Neither 37 CFR 1.193(b)(2) nor 37 CFR 41.39(a)(1), Authorizes the Examiner's Action

The examiner issued a final office action in response to an appeal brief. No rule authorizes the examiner to do that. Even if 37 CFR 1.193(b)(2) were applicable to the appeal proceeding in this application on 12/16/2004, the examiner's action would be improper, because it was not an office action pursuant to 37 CFR 1.192(b)(2), and because 37 CFR 1.192(b)(2) does not authorize a final action in response to an appeal brief.

2. 37 CFR 41.39(a)(1) Requires that the Examiner Mail an Examiner's Answer, Not an Office Action

The applicable rule is 37 CFR 41.39(a)(1). The examiner did not file an examiner's answer, as required, in response to an appeal brief. Accordingly, the examiner's action (issuing the 12/16/2004 office action) was improper.

Generally speaking, the examiner did not comply with the rules, and the rules have the force and effect of law. Thus, the examiner's actions were ultra vires, and therefore Director has no discretion in this matter. See generally, the APA (Administrative Procedures Act), at 5 USC 701 et seq. (administrative action not in accordance with law is improper.)

IV. Conclusion

The examiner did not comply with the rules of practice, and he did not comply with the Director's instruction in the prior petition in this application, both by mailing an office action, and by making the status of the application final. Accordingly, the office action should be vacated, and the Director should instruct the examiner to mail an examiner's answer, as specified by 37 CFR.

12/23/2004

Respectfully submitted,

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